

REMARKS

The Office Action mailed January 27, 2009, has been received and reviewed. Claims 1-7, 9-14, 16-29, 32, 33, and 36-63 are currently pending in the application. Claims 1-7, 9-14, 16-29, 32, 33, and 36-63 stand rejected. Applicants have amended claim 62, and respectfully request reconsideration of the application as amended herein.

Claim Objections

Claims 62 and 63 are objected to due to informalities in the claim language. Appropriate correction has been made.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on NYRA One Account (“NYRA”)

Claims 1-3, 5-7, 9, 10, 12-14, 16-20, 23-29, 32, 36-49, 51-55, and 58-63 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA One Account (“NYRA”). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Any differences between the prior art and the claims at issue must be such that they would not have been obvious to a person having ordinary skill in the art at the time the invention was made. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed, and such a reason “must be made explicit” by the Examiner. *Id.* at 1741. Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination of the references and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant’s disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006);

MPEP § 2144. Indeed, underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Applicants respectfully assert that the 35 U.S.C. § 103(a) obviousness rejections of claims 1-3, 5-7, 9, 10, 12-14, 16-20, 23-29, 32, 36-49, 51-55, and 58-63 are improper because NYRA fails to teach or suggest all of the limitations of at least independent claims 1, 24 and 40, and the differences between claims 1, 24 and 40 and the teachings of NYRA would not have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claims 1-3, 5-7, 9, 10, 12-14, 16-20, 23 and 60

The 35 U.S.C. § 103(a) obviousness rejections of independent claim 1 is improper because NYRA fails to teach or suggest “depositing funds into the monetary account at the gaming terminal” using at least one vehicle selected from the group consisting of cash, check, debit charge, credit card charge, and direct deposit,” as recited in claim 1.

NYRA teaches that deposits are made at the track by taking cash to a pari-mutuel window and receiving a voucher to be deposited with a Sam machine. *NYRA* at p. 2. For depositing a check, which may include money orders and traveler’s checks, NYRA requires that a patron “go to the Clubhouse Customer Services Booth[, f]ill out a deposit form and give it to any one of the Customer Service representatives on duty.” *Id.* at p. 2-3. Deposits by Credit Card require that a patron call an operator, who will transfer the patron to an agent who will process the request. *Id.* at p. 4.

The only teachings in NYRA regarding depositing funds using a Sam machine are limited to the use of a voucher. The voucher is only available by taking cash to a pari-mutuel window from which a user may obtain the voucher. Applicants respectfully note that a voucher is clearly taught as not being cash since cash is required to obtain a voucher, and is also clearly not a “check, debit charge, credit card charge, [or] direct deposit.” In fact, all of the methods taught and suggested by NYRA require that a patron contact a person either face-to-face or over the phone as opposed to using a gaming terminal. Indeed, each of such transactions is explicitly not carried out “at the gaming terminal.”

NYRA does indicate that funds may be acquired using checks and credit cards, but both these forms require the bearer to go to either the Customer Services Booth or call an operator by phone, be transferred to an agent and request the agent to process the credit card request. The Examiner asserts that funds may be transferred to a card holder's account from a Visa, MasterCard, or Discover Card, and that such a transfer occurs at a remote computer. *See, e.g., Office Action* at p. 14. However, Applicants respectfully point out that NYRA merely describes that the transfer of funds using a credit card must be carried out by calling an operator and being transferred to an agent who will process the credit card request. Applicants do not find any disclosure in NYRA of using a remote computer for such transactions. Furthermore, even if a remote computer is employed, such a remote computer is clearly not the gaming terminal since it is apparently only accessed by an agent who must be reached by phone. Therefore, the credit card transaction is not taught or suggested as being carried out "at the gaming terminal."

Applicants respectfully assert that NYRA does not teach or suggest at least "depositing funds into the monetary account at the gaming terminal using at least one vehicle selected from the group consisting of cash, check, debit charge, credit card charge, and direct deposit," as recited in independent claim 1, and these differences between claim 1 and the teachings of NYRA would not have been obvious to one of ordinary skill in the art at the time the invention was made. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 1.

The nonobviousness of independent claim 1 precludes a rejection of claims 2, 3, 5-7, 9, 10, 12-14, 16-20, 23 and 60, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 2, 3, 5-7, 9, 10, 12-14, 16-20, 23 and 60, in addition to the rejection to independent claim 1.

Regarding dependent claim 20, Applicants additionally assert that NYRA at least fail to teach or suggest "selecting the house card to be associated with a first monetary account and with a second monetary account associated with a debit card account or a credit card account, and using the at least a portion of the funds from the first monetary account to place the pari-mutuel

wager,” as recited in dependent claim 20. Indeed, nothing in NYRA teaches or suggests associating the house card with more than one monetary account. Therefore, Applicants respectfully assert that dependent claim 20 would not have been obvious to a person of ordinary skill in the art at the time the invention was made considering NYRA, and request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Claims 24-29, 32, 36-39 and 61-63

The rejection of independent claim 24 is improper because NYRA fails to disclose “presenting a house card associated with a monetary account to a card reader in communication with the gaming terminal to access at least a portion of funds of the monetary account for use at the gaming terminal by debiting the monetary account, the house card comprising an anonymous token card in which the identity of the player is not known to the establishment,” as recited in claim 24.

The Examiner admits that NYRA fails to teach or suggest that a user may obtain a card anonymously such that the identity of the player is not known to the establishment. *Office Action* at p. 11. The Examiner then takes official notice of the fact that “patrons prefer a more discrete playing experience and do not want perks associated with gambling amounts or other literature mailed to a home address, telephone number, or personal email account.” *Id.* When an Examiner takes official notice of a fact, “the basis for such reasoning must be set forth explicitly,” and the Examiner “must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusions of common knowledge.” MPEP §2143.03. Applicants assert that the Examiner has failed to provide any such explicit reasoning or specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. Applicants request that the Examiner provide such reasoning and details to satisfy the requirements of MPEP § 2143.03 or that the Examiner withdraw such official notice.

Furthermore, Applicants assert that even assuming such facts to be accurate, that “patrons prefer a more discrete playing experience and do not want perks associated with gambling amounts or other literature mailed to a home address, telephone number, or personal email

account,” an anonymous token card is not an obvious solution to these preferences. Indeed, without Applicants disclosure, one of ordinary skill in the art would be motivated to employ known methods to provide such a discrete playing experience, including providing the option to opt out of such literature, as is commonly employed by organizations. For example, the known method of providing this discrete playing experience free from perks associated with gambling amounts or other literature is to provide a means for a patron to opt out of such things, not to give the patron an anonymous token card. The Examiner’s use of hindsight is expressly prohibited in an obviousness analysis by the United States Supreme Court. *See KSR*, 127 S.Ct. at 1742.

Therefore, Applicants respectfully assert that NYRA does not teach or suggest at least “presenting a house card associated with a monetary account to a card reader in communication with the gaming terminal to access at least a portion of funds of the monetary account for use at the gaming terminal by debiting the monetary account, the house card comprising an anonymous token card in which the identity of the player is not known to the establishment,” as recited in independent claim 24, and these differences between claim 24 and the teachings of NYRA would not have been obvious to one of ordinary skill in the art at the time the invention was made. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 24.

Furthermore, the nonobviousness of independent claim 24 precludes a rejection of claims 25-29, 32, 36-39 and 61-63, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 25-29, 32, 36-39 and 61-63, in addition to the rejection to independent claim 24.

Claims 40-49, 51-55, 58 and 59

The rejection of independent claim 40 is improper because NYRA fails, at least, to disclose “placing a purchase of goods or services sold at an establishment, other than a pari-mutuel wager, over the communication link using another portion of the funds,” as recited in claim 40.

The Examiner asserts that it would have been obvious to use a cashless debiting system for both wagering and dining functions. However, Applicants respectfully point out that the Examiner has not even asserted any disclosure in NYRA teaching “placing a purchase of goods or services sold at an establishment, other than a pari-mutuel wager, over the communication link using another portion of the funds.”

NYRA is limited to placing a pari-mutuel wager using a card and a Sam or Tiny Tim machine at a race track or, alternatively, over the phone. The user is limited to placing only a wager and cannot make any purchases of goods or services using the card, and, more particularly, purchase goods or services over a communication link. Applicants further assert that the Examiner has not provided any reasoning as to how or why a person would be motivated to modify NYRA in such a manner to provide placing purchases over the communication link with the remote computer.

Applicants respectfully assert that NYRA does not teach or suggest at least “placing a purchase of goods or services sold at an establishment, other than a pari-mutuel wager, over the communication link using another portion of the funds,” as recited in independent claim 40, and these differences between claim 40 and the teachings of NYRA would not have been obvious to one of ordinary skill in the art at the time the invention was made. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 40.

Furthermore, the nonobviousness of independent claim 40 precludes a rejection of claims 41-49, 51-55, 58 and 59, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 41-49, 51-55, 58 and 59, in addition to the rejection to independent claim 40.

Regarding dependent claim 51, Applicants additionally assert that NYRA fails to teach or suggest “selecting the monetary account to be associated with a debit or credit card,” as recited in dependent claim 51. The Examiner fails to particularly recite any teaching or suggestion in NYRA relating the claim 51. Indeed, nothing in NYRA teaches a house card associated with a

debit or credit card account. Instead, a user must make a transfer from a separate, unassociated credit or debit card by calling an operator, be transferred to an agent, and then request the transfer. *See NYRA* at p. 4. If the account were associated with a credit or debit card, such a method for transferring funds from a credit or debit card would not be necessary. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Regarding dependent claim 55, Applicants additionally assert that NYRA fails to teach or suggest “selecting the house card to be associated with a first monetary account and with a second monetary account associated with a debit card account or a credit card account,” as recited in dependent claim 55. Nothing in NYRA teaches a house card associated with more than one account. Additionally, as discussed above, NYRA does not teach the use of a monetary account associated with a debit or credit card account. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of dependent claim 20 under 35 U.S.C. § 103(a) for this additional reason.

Obviousness Rejection Based on NYRA One Account (“NYRA”) in View of U.S. Patent No. 6,307,956 to Black

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA One Account (“NYRA”) in view of Black (U.S. Patent No. 6,307,956). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 4 is dependent from claim 1 and further requires using the house card to access a secure area at the establishment. The Examiner relies on NYRA as disclosing all of the limitations of claim 1 in combination with Black. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claim 1. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 4, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA One Account (“NYRA”) in View of U.S. Patent No. 6,558,255 to Walker et al.

Claims 11 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA One Account (“NYRA”) in view of Walker et al. (U.S. Patent No. 6,558,255).

Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 11 is dependent from claim 1 while claim 50 is dependent from claim 40. Claims 11 and 50 further require selecting the house card to have a predominated amount of funds. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Walker. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Thus, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 11 and 50, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA One Account (“NYRA”) in View of U.S. Patent No. 6,379,248 to Jorasch et al.

Claims 21, 22, 56 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA One Account (“NYRA”) in view of Jorasch et al. (U.S. Patent No. 6,379,248).

Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 21 and 22 depend indirectly from claim 1 while claims 56 and 57 depend indirectly from claim 40. The Examiner relies on NYRA as disclosing all of the limitations of claims 1 and 40 in combination with Jorasch et al. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 1 and 40. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 21, 22, 56 and 57, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

Obviousness Rejection Based on NYRA One Account (“NYRA”) in View of U.S. Patent No. 6,547,131 to Foodman et al.

Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over NYRA One Account (“NYRA”) in view of Foodman et al. (U.S. Patent No. 6,547,131). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claim 33 depends indirectly from claim 24. The Examiner relies on NYRA as disclosing all of the limitations of claim 24 in combination with Foodman as disclosing the limitations in claim 33. As stated above, NYRA fails to disclose, teach or suggest all of the limitations of independent claims 24. Therefore, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claim 33, since a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03.

ENTRY OF AMENDMENTS

The amendments to claim 62 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 1-7, 9-14, 16-29, 32, 33 and 36-63 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TJB', with a long horizontal flourish extending to the right.

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